

Filed on behalf of TRACBEAM, LLC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE US, INC., T-MOBILE USA, INC.,
TELECOMMUNICATION SYSTEMS, INC., ERICSSON INC., and
TELEFONAKTIEBOLAGET LM ERICSSON
Petitioners,

v.

TRACBEAM, LLC.
Patent Owner

Case No. IPR2015-01687
Patent 7,764,231

**PATENT OWNER'S PRELIMINARY RESPONSE TO THE PETITION
FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 7,764,231 UNDER 35
U.S.C. § 313 PURSUANT TO 37 C.F.R. § 42.107**

Table of Contents

I.	Introduction.....	1
II.	The Petitioners fail to satisfy their burden of demonstrating that the challenged claims are unpatentable.	1
A.	Petitioners' burden.	1
B.	Claim 17.	6
1.	“receiving location information...” (17.2).....	7
2.	“first obtaining” (17.3) and “second obtaining” (17.5)	8
3.	“wherein the second instance does not depend on a geographical location of the mobile station obtained from information indicative of a distance between the mobile station and at least one of the one or more satellites” (17.9).....	10
4.	“first value” and “second value” (17.10)	14
C.	Claim 20.	16
1.	“first receiving, from a first of said location techniques, first location information for the mobile station...” (20.4).....	16
2.	“second receiving, from a second of said location techniques, second location information for the mobile station...” (20.6)..	19
3.	“determining, a plurality of resulting location estimates for the mobile station...” (20.8)	21
D.	Claim 25.	23
1.	“first obtaining the first location information of said mobile station...” (25.7).....	23
2.	“second obtaining the second location information of said mobile station...” (25.8)	24
3.	“outputting, to a source for accessing location data” (25.9).....	25
III.	Conclusion.	28

Table of Authorities

Cases

<i>Apple Inc. v. ContentGuard Holdings</i> , IPR2015-00440, Paper 11 (July 13, 2015)	2
<i>Billy Goat Industries, Inc., v. Schiller Grounds Care, Inc.</i> , IPR2014-00742, Paper 8 (November 7, 2014)	5
<i>Christie Medical Holdings, Inc. v. The Research Foundation of The City College of New York</i> , IPR2015-00213, Paper 19 (September 18, 2015)	4
<i>Cisco Systems, Inc. v. C-Cation Technologies, LLC</i> , IPR2014-00454, Paper 12 (August 29, 2014)	4
<i>Kaneka Corp. v. Xiamen Kingdomway Grp. Co.</i> , 790 F.3d 1298 (Fed. Cir. 2015)	8
<i>Kloster Speedsteel AB v. Crucible, Inc.</i> , 793 F.2d 1565 (Fed. Cir. 1986)	3
<i>Liberty Mutual Insurance Co. v. Progressive Casualty Insurance Co.</i> , CBM-2012-00003 (Oct. 25, 2012)	6, 10, 16
<i>Synopsys, Inc. v. Mentor Graphics Corp.</i> , IPR2012-00041, Paper 16 (Feb. 22, 2013)	2, 3, 5
<i>Universal Remote Control, Inc. v. Universal Electronics, Inc.</i> , IPR2013-00152, Paper 8 (August 19, 2013)	3
<i>Whole Space Industries Ltd. v. Zipshade Industrial (B.V.I.) Corp.</i> , IPR2015-00488, Paper 14 (July 24, 2015)	5, 6, 22
<i>Wowza Media Systems, LLC and Coffee Cup Partners, Inc. v. Adobe Systems, Inc.</i> , IPR2013-00054, Paper 16 (July 13, 2013)	2, 18

Statutes

35 U.S.C. § 312	2, 5, 6, 22
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Regulations

37 C.F.R. § 42.104	passim
37 C.F.R. § 42.22	2, 4, 6, 22

Exhibit List

<u>Exhibit No.</u>	<u>Description</u>
2001	The American Heritage Dictionary, p. 575 (3 rd ed. 1994)
2002	Webster's New World College Dictionary, p. 996 (4 th ed. 2010)
2003	The American Heritage Dictionary, p. 235 (3 rd ed. 1994)

I. Introduction.

In this Petition for *Inter Partes* Review, the Petitioners assert a single ground: that claims 17, 20, 25, and 26 of the '231 Patent are obvious based on a combination of Loomis and Wortham. Pet. at 34.

For independent claim 17, the Petition fails to demonstrate that each claim element is found in the asserted combination.

For independent claims 20 and 25, the Petition primarily relies upon its analysis of claim 17. This is fatal because (a) that analysis fails as to claim 17 and furthermore (b) does not apply to claims 20 and 25, which recited several different claim limitations not found in claim 17. The Petition also fails as to dependent claim 26 for at least the reasons it fails as to base claim 25.¹

Accordingly, the Petition should be denied as to all claims.

II. The Petitioners fail to satisfy their burden of demonstrating that the challenged claims are unpatentable.

A. Petitioners' burden.

The controlling statute requires that a petition for *inter partes* review “identif[y]...with particularity...the evidence that supports the grounds for the

¹ In addition, claim 26 is no longer asserted in the co-pending litigation and the Petitioners have agreed to withdraw their challenge to that claim.

challenge to each claim.” 35 U.S.C. § 312(a)(3)²; *Apple Inc. v. ContentGuard Holdings*, IPR2015-00440, Paper 11 at 5-6 (July 13, 2015) (“a petition for inter partes review must ‘identif[y], in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.’”) (*quoting* 35 U.S.C. § 312(a)(3)).

The corresponding regulation requires that a petition include a “detailed explanation of the significance of the evidence.” 37 C.F.R. § 42.22(a)(2); *Synopsys, Inc. v. Mentor Graphics Corp.*, IPR2012-00041, Paper 16 at 14 (Feb. 22, 2013) (“Per 37 C.F.R. § 42.22(a), each petition must include ... a detailed explanation of the significance of the evidence.”).

To satisfy these requirements, a petition must, for each challenged claim, “identify... [h]ow the construed claim is unpatentable” (37 C.F.R. § 42.104(b)(4)) and “specify where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4). “[F]ailure to point out where each element is found in the prior art is a deficiency in the substantive requirements of the petition,” which warrants denial under Section 42.104(b)(4). *Wowza Media Systems, LLC and Coffee Cup Partners, Inc. v. Adobe Systems, Inc.*, IPR2013-00054, Paper 16 at 3 (July 13, 2013).

² Emphasis added unless otherwise noted.

In addition, a Petition must, for each challenged claim, also identify: “the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge.” 37 C.F.R. § 42.104(b)(5). “In accordance with 37 C.F.R. § 104(b)(5), the relevance of the evidence supporting the challenge must be provided including identification of specific portions of the evidence that support the challenge.” *Synopsys, Inc. v. Mentor Graphics Corp.*, IPR2012-00041, Paper 16 at 12, 14 (Feb. 22, 2013) (finding that “Petitioner’s conclusory statements, without more detail, fail to satisfy” 37 C.F.R. §§ 42.104(b)(4) and 42.104(b)(5), among other requirements).

Based on the controlling statute and regulations set forth above, to satisfy its burden, a petition must:

- (1) address “each element” of each challenged claim (37 C.F.R. § 42.104(b)(4))—if a ground fails to address even a single claim element, the Petition must be denied as to that ground. *See Universal Remote Control, Inc. v. Universal Electronics, Inc.*, IPR2013-00152, Paper 8 at 17 (August 19, 2013) (“‘[A]bsence from the reference of any claimed element negates anticipation.’ *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986) (citation omitted), *overruled on other grounds by Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337 (Fed. Cir. 2004).

Petitioner has failed to identify any disclosure ... that meets all the requirements of claim 1.”).

- (2) provide a “detailed explanation of the significance of the evidence” (37 C.F.R. § 42.22(a)(2) and “the relevance of the evidence” (37 C.F.R. § 42.104(b)(5)) rather than conclusory assertions as to how each element is found in the reference. *Cisco Systems, Inc. v. C-Cation Technologies, LLC*, IPR2014-00454, Paper 12 at 11 (August 29, 2014) (“The Petition before us does not... include a detailed explanation of the significance of the quotations and citations from the applied references.”) (*citing* 37 C.F.R. §§ 42.104(b)(4)), 42.22(a)(2)); *Christie Medical Holdings, Inc. v. The Research Foundation of The City College of New York*, IPR2015-00213, Paper 19 at 7 (September 18, 2015) (“We found Petitioner’s argument conclusory, lacking sufficient explanation for how the cited evidence... support the anticipation of the challenged claims.”). “As explained in the Office Patent Trial Practice Guide, parties requesting *inter partes* review should ‘....focus on concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence of record.’” *Whole Space Industries Ltd. v. Zipshade Industrial (B.V.I.) Corp.*,

IPR2015-00488, Paper 14 at 9 (July 24, 2015) (*quoting* 77 Fed. Reg. 48,756, 48,763 (Aug. 14, 2012)).

- (3) point “with particularity” (35 U.S.C. § 312(a)(3)) to specific language in the reference that anticipates each element—a petition must “identify[] specific portions of the evidence” (37 C.F.R. § 42.104(b)(5)) rather than block cite multiple paragraphs or pages from a reference. “Because the petition does not clearly point to specific language in [a reference] that anticipates each element of [the challenged claims], we decline to institute an *inter partes* review on the basis of anticipation by [the reference].” *Synopsys, Inc. v. Mentor Graphics Corp.*, IPR2012-00041, Paper 16 at 16 (Feb. 22, 2013).

A Petition should be denied if the Petition forces the Patent Owner and the Board to piece together the evidence to attempt to establish Petitioner’s ground:

It is Petitioner’s responsibility to explain specific evidence that supports its arguments, not the Board’s responsibility to search the record and piece together what may support Petitioner’s arguments.

Billy Goat Industries, Inc., v. Schiller Grounds Care, Inc., IPR2014-00742, Paper 8 at 28 n. 4 (November 7, 2014).

[W]e will address only the basis, rationale, and reasoning put forth by the Petitioner in the petition, and resolve all vagueness and ambiguity in Petitioner’s arguments against the Petitioner.

Liberty Mutual Insurance Co. v. Progressive Casualty Insurance Co., CBM-2012-00003, Paper 8 at 10 (Oct. 25, 2012).

The Petition improperly shifts the burden of deciphering Petitioner's arguments onto Patent Owner and the Board, which, as we discussed above, is contrary to the statutory and regulatory provisions governing *inter partes* review proceedings, as well as the best practices outlined in the Office Patent Trial Practice Guide.

Whole Space Industries Ltd. v. Zipshade Industrial (B.V.I.) Corp., IPR2015-00488 Paper 14 at 18 (July 24, 2015) (*citing* 35 U.S.C. § 312(a)(3); 37 C.F.R. §§ 42.22(a)(2), 42.104(b)(4)–(5)).

Here, the Petitioners fail to satisfy this burden for each challenged claim. Each claim is addressed in turn.

B. Claim 17.

Petitioners assert that the combination of Loomis and Wortham renders claim 17 obvious. Petitioners' analysis of Loomis and Wortham contains several errors and omissions. Many of the errors and omissions cannot be demonstrated with sufficient clarity at this stage in the proceeding, as they would require deposition testimony to unravel. However, because (a) Petitioners rely exclusively on Loomis for claim element 17.9 (using the labels the Petition uses), and (b)

Loomis does not disclose, and in fact teaches away from that limitation, the Petition must be denied.

In addition, Petitioners fail to meet their burden of demonstrating that claim elements 17.2, 17.3, 17.5, and 17.9 are disclosed in the asserted combination.

1. “receiving location information...” (17.2)

Element 17.2 recites: “receiving location information for the mobile station by the steps (a) and (b) following.” ‘231, col. 177:22-23. The Petition relies solely on Loomis for this element, asserting:

As explained in Section IX.D.1, *Loomis*’ location system includes GPS and radio location techniques that provide location information of the mobile station using wireless signal measurements. (*See* Section IX.D.1 (Overview); Ex. 1008 (*Loomis*) at 11:49-12:15, 19:32-47.)

Pet. at 35.

The Petition’s conclusory analysis does not even mention the “receiving” limitation, much less demonstrate that the required receiving act is disclosed by Loomis. Moreover, the Petition fails to identify any “computational equipment” in Loomis that performs the receiving act. Element 17.1 requires that all steps of claim 17, including element 17.2’s act of “receiving location information,” be performed “by computational equipment.” ‘231, col.177:20-21. The Petition does not identify anything that receives the claimed “location information” and does not

contain any assertion that the receiving is performed by computational machinery.

Accordingly, Petitioners fail to “specify where each element of the claim is found in the prior art patents or printed publications relied upon” (37 C.F.R. § 42.104(b)(4)) and therefore have not satisfied their burden as to element 17.2.

2. “first obtaining” (17.3) and “second obtaining” (17.5)

“Where the steps of a method claim actually recite an order, we ordinarily construe the claim to require order.” *Kaneka Corp. v. Xiamen Kingdomway Grp. Co.*, 790 F.3d 1298, 1306 (Fed. Cir. 2015). Claim 17 recites an order. The “first obtaining” act and “second obtaining” act must be performed in that order.

“(a) first obtaining a first instance of the location information when supplied with signal time delay data obtained from wireless signal data received by the mobile station from a satellite,” ‘231, col. 177:24-27;

“(b) second obtaining a second instance of the location information of the mobile station when supplied with second data indicative of time delays of wireless signals transmitted between the mobile station and a plurality of terrestrial transceivers.” *Id.*, col. 177:33-37.

This is because “first” and “second” are used as adverbs to describe the manner in which the recited acts are performed (one before the other), not as “numeric modifiers” used to simply distinguish between the two steps, as the Petition asserts. Pet. 12. If this *Inter Partes* Review is instituted, Patent Owner

will demonstrate that “first” and “second” are used as adverbs to describe the manner in which the recited acts are performed and will further demonstrate that Petitioners’ asserted combination fails to disclose or render obvious the ordered “obtaining” steps of claim 17.³ But we need not do so here because Petitioners fail to meet their burden for the simple reason that they fail to identify any “obtaining” act (whether performed “first” or “second”).

The act of “obtaining” something (in this case the instances of “location information”) requires acquiring or gaining possession of that thing. *See, e.g.,* Ex. 2001-2002. *The American Heritage Dictionary*, p. 575 (3rd ed. 1994) (obtain: “v. 1. To succeed in gaining possession of; acquire.”); *Webster’s New World College Dictionary*, p. 996 (4th ed. 2010) (“1 to get possession of, esp. by some effort; procure”). Petitioners fail to demonstrate that this occurs in Loomis.

For the “first obtaining” step the Petition asserts “in *Loomis*, the mobile station includes a GPS receiver/processor that obtains GPS location information of the mobile station (i.e., ‘*first obtaining a first instance of the location information*’).” Pet. 36. And for the “second obtaining” step the Petition asserts: “in Loomis, the mobile station includes a radio receiver/processor that obtains

³ Patent Owner will also show this for the ordered “obtaining” steps of claim 25 and the ordered “receiving” steps of claim 20.

location information of the mobile station (i.e., ‘*second obtaining a second instance of the location information*’).” Pet. at 38. The Petition simply parrots the claim language and says this is found in Loomis. But nowhere does the Petition identify the acts of “obtaining” that it is relying upon. The Petition also fails to acknowledge or support its implied premise that the act of *determining* the “location information” (which the Petition identifies as the calculated GPS estimate and the calculated radio location technique estimate) is the same thing as “obtaining” that location information, or that it necessarily results in the recited acts of obtaining. Petitioners have therefore failed to meet their burden. *Liberty Mutual Insurance Co. v. Progressive Casualty Insurance Co.*, CBM-2012-00003, Paper 8 at 10 (Oct. 25, 2012) (“[W]e will address only the basis, rationale, and reasoning put forth by the Petitioner in the petition, and resolve all vagueness and ambiguity in Petitioner’s arguments against the Petitioner.”).

3. “wherein the second instance does not depend on a geographical location of the mobile station obtained from information indicative of a distance between the mobile station and at least one of the one or more satellites” (17.9)

Element 17.9 provides: “wherein the second instance does not depend on a geographical location of the mobile station obtained from information indicative of a distance between the mobile station and at least one of the one or more

satellites.” ‘231, col. 177:49-53. For this element, Petitioners rely exclusively on Loomis. They identify the claimed “second instance” as the radio location information calculated by the radio technique:

The radio location information (*i.e.*, “second instance of the location information”) includes the present radio location coordinates $(x_u, y_u, z_u)_{rad}$ and associated radio signal indicium I_{rad} .

Pet. at 38-39. And for the “geographical location of the mobile station obtained from information indicative of a distance between the mobile station and at least one of the one or more satellites,” Petitioners identify the location calculated by the GPS technique. Pet. at 42. Thus, to satisfy its burden with respect to element 17.9, Petitioners needed to demonstrate that the radio location information “does not depend on a geographical location of the mobile station obtained” from the GPS technique. They fail to do so.

Here is the entirety of the Petition’s analysis of element 17.9:

Loomis discloses that the GPS technique “operates independently” of the radio technique and that each of these techniques “provid[es] an independent determination of location” (*i.e.*, “*the second instance*” obtained by the radio technique “*does not depend on a geographical location of the mobile station obtained [by the GPS technique] from information indicative of a distance between the mobile station and at least one of the one or more satellites*”). (Ex. 1008 (*Loomis*) at 5:7-9, 7:41-44.).

Pet. at 42.

This analysis fails. There is no support in Loomis for Petitioners' suggestion that the claimed "second instance" calculated by the radio technique *"does not depend on a geographical location of the mobile station obtained [by the GPS technique]."* Pet. at 42. The Petition cites Loomis at 5:7-9, and 7:41-44, but neither cited passage supports Petitioners' assertion. Both passages state that the outdoor LD (which is used for the GPS technique) operates independently of the radio LD system (Petitioner's "second instance"). But these passages do not state the converse: that the radio LD system (Petitioner's "second instance") operates independently of the GPS technique. That is what would be needed for Loomis to support the Petition's assertion.

Moreover, that the outdoor LD system operates independently of the radio LD system does not suggest that the converse is true. As an analogy, the weather operates independently of how many people are having picnic in the park. But the number of people having a picnic in the park can and does depend on the weather. Therefore, the Petition's cites to these passages from Loomis do not satisfy Petitioners' burden of demonstrating that Loomis discloses element 17.9.

In addition, the estimate calculated by the radio technique in Loomis (i.e., what Petitioners identify as the "second instance") does depend on a geographical location obtained from the GPS technique. As the Petition acknowledges, the radio technique relies on signal phase measurements to operate: Loomis' "radio

technique calculates the location of a hybrid LD device (*i.e.*, a mobile station) using signal phase measurements.” Pet. at 22. These signal phase measurements in turn depend on the location estimate determined by the outdoor LD (GPS) module:

The outdoor LD unit 31 determines the (approximate) location of itself and of the adjacent radio LD unit 13 and uses this information in determining the relative phases of the radio LD signals transmitted by the sources 21, 23 and 25. Use of a mobile outdoor LD unit 31 to receive radio LD signals and to determine the relative phases of such signals is an important feature of the invention.

Loomis 7:31-38; Fig. 9 (“Outdoor LD Unit Determines Its Location and Relative Phases of Radio LD Signals”).

Therefore, the radio technique relies on the location estimate determined by the outdoor LD module. This is important because the location estimates determined by the LD module are “geographical location obtained from information indicative of a distance between the mobile station and at least one of the one or more satellites.” The geographical location obtained by the outdoor LD module is from the GPS technique, which uses information indicative of a distance between the mobile station and at least one or more satellites. Pet. at 19 (“*Loomis* discloses that the mobile station includes a GPS signal receiver/processor (referred to in Loomis as the “outdoor LD unit”) that receives wireless signals from satellites and uses those signals to estimate a location of the mobile station.”); Ex. 1006 at

¶199 “GPS calculations are performed by measuring the signal travel time delay of the received GPS signals.”); Pet. at 18 (“*Loomis*’ location system includes a GPS technique (*i.e.*, the outdoor LD module)”).

Accordingly, that the radio technique relies upon location estimates from the outdoor LD module means that technique and its output depends on a geographical location obtained from information indicative of a distance between the mobile station and at least one of the one or more satellites. *Loomis* therefore not only fails to disclose but teaches away from element 17.9’s requirement that “the second instance does not depend on a geographical location of the mobile station obtained from information indicative of a distance between the mobile station and at least one of the one or more satellites.”

4. “first value” and “second value” (17.10)

Element 17.10 recites:

(A2) determining resulting location information, for each of one or more locations of said mobile station, using at least one of: a first value obtained from the first instance, and a second value obtained from the second instance;

(A3) outputting said resulting location information for each of the one or more locations; wherein: the first value is used to obtain the resulting

information for one of the locations, and the second value is used to obtain the resulting information for one of the locations.

‘231, col. 177:54-63.

The Petition addresses element 17.10 and cites the claim language in parenthetical statements. Pet. 43-44. But the Petition does not clearly identify what it is in Loomis that Petitioners contend is the “first value obtained from the first instance,” the “second value obtained from the second instance,” or how either of these values are “used to obtain” resulting information. The Petition asserts:

Loomis teaches that its location system typically uses the GPS location information as the resulting location information when the mobile station is outside of a building (*i.e.*, “*the first value is used to obtain the resulting information for one of the locations*”), and uses the radio location information as the resulting location information when the mobile station is inside of a building (*i.e.*, “*the second value is used to obtain the resulting information for one of the locations*”). (*Id.* at 18:27-32, 20:21-28.).

Pet. at 43-44. This sentence implicitly identifies the “first value” as “the GPS location information” and the “second value” as “the radio location information,” but fails to identify what the Petition means by that (e.g., what GPS location information—the satellite measurements, the calculated location, the accuracy?) and how these two items of “location information” are “obtained from” the “first instance” and the “second instance,” respectively. The Petition has therefore also

failed to clearly demonstrate that Loomis (or the asserted combination) element 17.10. *Liberty Mutual Insurance Co. v. Progressive Casualty Insurance Co.*, CBM-2012-00003, Paper 8 at 10 (Oct. 25, 2012) (“[W]e will address only the basis, rationale, and reasoning put forth by the Petitioner in the petition, and resolve all vagueness and ambiguity in Petitioner’s arguments against the Petitioner.”).

C. Claim 20.

As shown below, the Petition’s analysis of independent claim 20 fails because it relies on the Petition’s analysis of claim 17, which has different elements and limitations.

1. “first receiving, from a first of said location techniques, first location information for the mobile station...” (20.4).

Element 20.4 requires:

(a) first receiving, from a first of said location techniques, first location information for the mobile station, wherein said corresponding input information for said first location technique includes timing data from wireless signals transmitted from one or more global positioning satellites, and received by the mobile station...

231, col. 179:18-24.

The Petition's entire analysis of this element is as follows:

20.4 (a) first receiving, from a first of said location techniques, first location information for the mobile station, wherein said corresponding input information for said first location technique includes timing data from wireless signals transmitted from one or more global positioning satellites, and received by the mobile station,

See Analysis for Claim Element 17.3.

Pet. at 47. This is insufficient to satisfy Petitioners' burden.

A Petitioner cannot satisfy its burden of showing that an element in one independent claim is found in the prior art merely by point back to its analysis of another element, of an entirely different claim, that has different limitations. But that is exactly what Petitioners have attempted here.

Element 17.3 provides:

first obtaining a first instance of the location information when supplied with signal time delay data obtained from wireless signal data received by the mobile station from a satellite, wherein a geographic range corresponding to the signal time delay data is used to determine the first instance.

'231, col. 177:24-29. This element from claim 17 has several significant differences from element 20.3 from claim 20, as shown in following redline comparing the differences between the two elements.

“(a) first ~~obtaining-receiving, from~~ a first ~~instance~~ of ~~thesaid~~ location techniques, first location information ~~when-supplied-with-signal-time~~

delay for the mobile station, wherein said corresponding input information for said first location technique includes timing data obtained from wireless signal data signals transmitted from one or more global positioning satellites, and received by the mobile station from a satellite, wherein a geographic range corresponding to the signal time delay data is used to determine the first instance.” station

As this comparison demonstrates, element 17.3 does not contain several significant limitations that are found in element 20.4 including:

- “first receiving,”
- “first of said location techniques,” and
- “corresponding input information for said first location technique.”

As a result, Petitioners’ analysis of element 17.3 does not assert—much less demonstrate how—any of these limitations from element 20.4 are found in Loomis. Pet. at 36-37. Petitioners’ cross-reference to claim element 17.3 fails to mention, much less address, “first receiving,” or “receiving” at all. Petitioners’ cross-reference to element 17.3 similarly does not purport to identify a “first of said location techniques” or “corresponding input information for said first location technique.”

Accordingly, Petitioners fail to satisfy their burden of demonstrating that these elements are met or rendered obvious by the asserted art. *Wowza Media Sys., LLC et al. v. Adobe Sys., Inc.*, IPR2013-00054, Paper 16 at 3 (July 13, 2013)

(“failure to point out where each element is found in the prior art is a deficiency in the substantive requirements of the petition,” which warrants denial under Section 42.104(b)(4)).

2. “second receiving, from a second of said location techniques, second location information for the mobile station...” (20.6).

Element 20.6 requires:

second receiving, from a second of said location techniques, second location information for the mobile station, wherein said corresponding input information for said second location technique includes data that is a function of a signal time delay of wireless signals transmitted between the wireless mobile station and one of said plurality of fixed location terrestrial stations during a plurality of transmissions between the mobile station and the one terrestrial station.

‘231, col. 179:31-40.

The Petition’s entire analysis of this element is as follows:

20.6 (b) second receiving, from a second of said location techniques, second location information for the mobile station, wherein said corresponding input information for said second location technique includes data that is a function of a signal time delay of wireless signals transmitted between the wireless mobile station and one of said plurality of fixed location terrestrial stations during a plurality of transmissions between the mobile station and the one terrestrial station;

See Analysis for Claim Element 17.5.

Pet. at 49.

This cite-back approach again fails. Claim element 17.5 from is not the same as Claim element 20.6. The two elements have several significant differences as demonstrated in the redline comparing claim elements 17.5 and 20.6 depicting the differences in the elements:

(b) second ~~obtaining~~receiving, from a second ~~instance~~of the said location techniques, second location information ~~of~~for the mobile station ~~when~~supplied with second, wherein said corresponding input information for said second location technique includes data ~~indicative of~~that is a function of a signal time ~~delays~~delay of wireless signals transmitted between the wireless mobile station and ~~a~~one of said plurality of fixed location terrestrial ~~transceivers cooperatively linked together for use in two way~~communication with stations during a plurality of transmissions between the mobile station and the ~~mobile~~one terrestrial station;

As reflected in the comparison above, unlike claim element 20.6, claim element 17.5 does not have the following claim limitations:

- “second receiving,”
- “second of said location techniques,”
- “corresponding input information for said second location technique,”
- “data that is a function of a signal time delay of wireless signals,” or

- “plurality of transmissions between the mobile station and the one terrestrial station.”

As a result, Petitioners’ analysis of claim element 17.5 does not contain any discussion or assertion that any of these elements are found (or rendered obvious) in claim element 20.6 based on the asserted combination. Pet. at 38-40.

Accordingly, Petitioners do not satisfy their burden of demonstrating that these limitations are disclosed or rendered obvious by the asserted art.

3. “determining, a plurality of resulting location estimates for the mobile station...” (20.8)

Element 20.8 requires:

determining, a plurality of resulting location estimates for the mobile station, wherein said step of determining includes steps (c) and (d) following: (c) obtaining at least one of said resulting location estimates using an instance (I1) of said first location information for locating the mobile station; and (d) obtaining at least one of said resulting location estimates using an instance (I2) of said second location information for locating the mobile station.

‘231, col. 179:50-58.

The Petition’s entire analysis of this element is as follows:

For the reasons presented with respect to Claim Element 17.10, *Loomis* satisfies this claim element. Moreover, *Loomis* discloses determining “the present location of the user [] at selected times (e.g., second-by-second, or more or less often, if desired)” (*i.e.*, “*determining, a plurality of resulting location estimates*”). (Ex. 1008 (*Loomis*) at 8:26-35.)

Pet. 50-51.

This discussion also fails to satisfy Petitioners’ burden. Cross-referenced claim element 17.10 does contain any of the following limitations found in claim element 20.8:

- “a plurality of resulting location estimates for the mobile station,”
- “step of determining includes steps (c) and (d),”
- “instance (I1) of said first location information for locating the mobile station,” and
- “instance (I2) of said second location information for locating the mobile station.”

Accordingly, Petitioners’ analysis of claim 17.10 fails to address or analyze any of these limitations from claim element 20.8 or assert that these elements are found in *Loomis*. Pet. at 43-44. Therefore, Petitioners do not satisfy their burden of demonstrating that these limitations are met or rendered obvious by the asserted art. *Whole Space Ind. V. Zipshade Industrial*, IPR2015-00488, Paper 14 at 18

(July 24, 2015) (“The Petition improperly shifts the burden of deciphering Petitioner’s arguments onto Patent Owner and the Board, which, as we discussed above, is contrary to the statutory and regulatory provisions governing *inter partes* review proceedings, as well as the best practices outlined in the Office Patent Trial Practice Guide.” (citing 35 U.S.C. § 312(a)(3); 37 C.F.R. §§ 42.22(a)(2), 42.104(b)(4)–(5)).

D. Claim 25.

As shown below, the Petition’s analysis of independent claim 25 fails because—as was the case with claim 20—it heavily relies on the Petition’s analysis of claim 17, which has different elements and limitations.

1. “first obtaining the first location information of said mobile station...” (25.7)

Claim element 25.7 requires:

first obtaining the first location information of said mobile station, the first location information determined by computational machinery when said corresponding location technique for using the first collection is supplied with an instance of said first collection.

‘231, col. 180:57-61.

The Petition’s entire analysis of this element is as follows:

See Claim Element 17.3 Analysis (and 17.1 for “computational machinery”).

Pet. at 58.

This assertion fails to satisfy Petitioners’ burden. Claim element 17.3 is not the same as claim element 25.6. For example, element 17.3 does not include the limitation: “the first location information determined by computational machinery when said corresponding location technique for using the first collection is supplied with an instance of said first collection.” As a result, Petitioners’ cross-referenced analysis of claim 17 contains no analysis or discussion of this claim element. Pet. at 36. The Petition simply fails to address any of the differences between claim elements 25.7 and 17.3.

Accordingly, Petitioner does not satisfy its burden of showing that this element is disclosed or rendered obvious.

2. “second obtaining the second location information of said mobile station...” (25.8)

Claim element 25.8 requires:

second obtaining the second location information of said mobile station, the second location information determined by computational machinery when said corresponding location technique for receiving the second collection is supplied with an instance of said second collection.

‘231, col. 180:62-67.

The Petition’s entire analysis of this element is as follows:

See Claim Element 17.5 Analysis (and 17.1 for “computational machinery”).

Pet. at 58. This does not satisfy Petitioners’ burden.

Claim element 17.5 is not the same as claim element 20.6. For example, Claim 17 does not contain the limitation: “second location information determined by computational machinery when said corresponding location technique for receiving the second collection is supplied with an instance of said second collection.” As a result, Petitioners’ analysis of claim 17 does not mention this limitation at all, much less provide any analysis or discussion of the limitation. Pet. at 38-40. The Petition again fails to address any of the differences between the elements of claim 25 and claim 17. Accordingly, Petitioners fail to “specify where each element of the claim is found in the prior art,” 37 C.F.R. § 42.104(b)(4), and therefore do not meet their burden.

3. “outputting, to a source for accessing location data” (25.9)

Element 25.9 requires:

outputting, to a source for accessing location data for said mobile station, resulting location information that is dependent upon: at least one of said

first and second location information, and also dependent upon data for indicating a likelihood of the mobile station being in a geographical extent represented by of at least one of said first location information and said second location information.

‘231, col. 181:1-8.

A “source for accessing location data” is place or location from which the location data can be accessed or obtained. *See* Ex. 2003 Random House Webster’s Dictionary, p. 688 (4th ed. 2001) (source: “n. 1. any thing or place from which something comes or is obtained.”). Petitioners identify no such source in Loomis or in the asserted combination. In the single sentence in which Petitioners address this claim requirement, they assert:

Loomis’ location system transmits (i.e., “outputting”) the selected location estimate (i.e., “resulting location information”) to an interested person or facility (i.e., “a source for accessing location data for said mobile station”). (Ex. 1008 (Loomis) at 5:14-22, 12:30-40; *see also id.* at 12:62-13:1.)

Pet. at 59-60.

This assertion fails. The Petition does not explain how the identified “person or facility” is a “source for accessing location data for said mobile station,” as required by this claim element. Moreover, the cited portion of Loomis does not suggest or disclose that the “interested person or facility” in Loomis acts as a “source for accessing location data” for the identified mobile station.

The Petition provides three cites to Loomis: (1) 5:14-22, (2) 12:30-40; and (3) 12:62-13:1. Each is addressed in turn.

(1) Loomis at 5:14-22 does not mention an “interested person or facility,” much less suggest that the interested person or facility act as a source for accessing location data. Loomis, col. 5:14-22.

(2) Loomis at 12:30-40 is reproduced below:

In one embodiment, the I/O port includes a cellular communication means **101** with associated cellular antenna **103** for communicating with another person or facility by cellular telecommunications, the cellular means being connected to the controller module **93**. At one or more selected times, or upon receipt by the controller module **93** of a command by radiowave signals or telecommunication signals, the controller module causes the cellular communication means **101** to send information on the present or recent location of the LD unit 11 to a person or facility spaced apart from this LD unit.

Loomis, col. 12:30-40.

This section states that (1) the “person or facility” can be communicated with by cellular telecommunications, and (2) that “information on the recent or present location” can be sent to the person or facility. There is no suggestion in this passage that the identified person or facility acts as “source for accessing

location data” (e.g., as a database or repository from which the location data can be accessed or obtained).

(3) Loomis at 12:62-13:1 states that the controller module can “notif[y] any interested person or facility that the methods used for location determination have an unacceptably high errors associated with them and should not be used, or should be used with caution.” Loomis, col. 12:62-13:1. This passage also fails to disclose a “source for accessing location data;” instead, it states that location data is not sent to the interested party or facility in some cases.

Accordingly, the passages from Loomis cited by Petitioners provide no support for the suggestion that the “person or facility” satisfy the “source for source for accessing location data” requirement. And Petitioners have failed in their analysis to demonstrate this requirement is met or rendered obvious by Loomis.

III. Conclusion.

For the reasons explained above, Petitioners fail to meet their burden. Thus, the Petition should be denied.

Respectfully submitted,

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Certificate of Filing and Service

I hereby certify that a true and correct copy of the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE TO THE PETITION FOR INTER PARTES REVIEW UNDER 35 U.S.C. § 313 PURSUANT TO 37 C.F.R. § 42.107** together with **EXHIBITS 2001, 2002, and 2003** are being filed via PRPS and served by electronic mail this 13th day of November, 2015 on counsel for Petitioners as follows:

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